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 Robert C. Kowert  
 Conley, Rose & Tayon, P.C.  
 P.O. Box 398  
 Austin, TX 78767

EXAMINER
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TOMASZEWSKI, MICHAEL

ART UNIT	PAPER NUMBER
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3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/045,649

Applicant(s)

MORIMOTO, NOBUYOSHI

Examiner

Mike Tomaszewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Notice To Applicant*

1. This communication is in response to the amendment filed on 10/19/06. Claim 11 has been amended. Claims 1-20 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 8, 12-15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Parcel Insurance Plan* ([www.pipinsure.com](http://www.pipinsure.com); hereinafter *Pipinsure*), in view of *Keuper* (DE 44 46 203 A1; see English translation; hereinafter *Keuper*).

(A) As per previously amended claim 1, *Pipinsure* discloses a method for arranging insurance for an item, wherein the method comprises:

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- (1) receiving a request to insure the item being shipped from an origination to a final destination (*Pipinsure*: pg. 8);
- (2) searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item (*Pipinsure*: pg. 1);
- (3) generating a data file comprising at least the following:
  - (i) item information (*Pipinsure*: pg. 8); and
  - (ii) insurer information (*Pipinsure*: pg. 8).

*Pipinsure*, however, fails to expressly disclose a method for arranging insurance for an item, wherein the method comprises:

- (4) storing the data file in a memory device that accompanies the item.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses a method for arranging insurance for an item, wherein the method comprises:

- (4) storing the data file in a memory device that accompanies the item (*Keuper*. abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Keuper* with the teachings of *Pipinsure* with the motivation of acquiring shipment-handling data on an item (*Keuper*. abstract).

(B) As per original claim 2, *Pipinsure* fails to expressly disclose the method as recited in claim 1, wherein the memory device is configured to allow the data file to be updated at any time before, during or after the shipment.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, wherein the memory device is configured to allow the data file to be updated at any time before, during or after the shipment (*Keuper*. abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Keuper* with the teachings of *Pipinsure* with the motivation of acquiring shipment-handling data on an item (*Keuper*. abstract).

(C) As per original claim 3, *Pipinsure* fails to expressly disclose the method as recited in claim 1, further comprising packing the item in a container for shipping, wherein the container is configured to fit with multiple other containers in a carrier.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, further comprising packing the item in a container for shipping, wherein the container is configured to fit with multiple other containers in a carrier (*Keuper*. abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Keuper* with the teachings of *Pipinsure* with the motivation of acquiring shipment-handling data on an item (*Keuper*. abstract).

(D) As per original claim 8, *Pipinsure* discloses the method as recited in claim 1, wherein the data file further comprises contact information for at least one of the insurance companies that will insure the item (*Pipinsure*: pg. 2-3).

(E) As per original claim 12, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, wherein the data tile further comprises item weight information.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, wherein the data tile further comprises item weight information (*Keuper*. abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Keuper* with the teachings of *Pipinsure* with the motivation of acquiring shipment-handling data on an item (*Keuper*. abstract).

(F) As per original claim 13, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, wherein the data file further comprises item handling information.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, wherein the data file further comprises item-handling information (*Keuper*. abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Keuper* with the teachings of *Pipinsure* with the motivation of acquiring shipment-handling data on an item (*Keuper*: abstract).

(G) As per original claim 14, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, wherein the data file further comprises item content information.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, wherein the data file further comprises item content information (*Keuper*: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Keuper* with the teachings of *Pipinsure* with the motivation of acquiring shipment-handling data on an item (*Keuper*: abstract).

(H) As per original claim 15, *Pipinsure* discloses the method as recited in claim 1, wherein the data file further comprises insurance information (*Pipinsure*: pg. 8).

(I) Claim 20 substantially repeats the same limitations as claim 1 and therefore, is rejected for the same reasons given for claim 1 and incorporated herein.

4. Claims 4, 6, 9, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Pipinsure* and *Keuper*, as applied to claim 1 above, and further in view of *Kadaba et al.* (6,285,916; hereinafter *Kadaba*).

(A) As per original claim 4, *Pipinsure* discloses the method as recited in claim 1, further comprising forwarding copies of at least a portion of the data file via the network to at least one insurance company (*Pipinsure*: pg. 8).

*Pipinsure*, however, fails to expressly disclose the method as recited in claim 1, further comprising forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, further comprising forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination (*Kadaba*: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Kadaba* with the combined teachings of *Pipinsure* and *Keuper* with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (*Kadaba*: col. 3, lines 40-64).



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(B) As per original claim 6, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, further comprising forwarding a copy of the data file via a network to a central server.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, further comprising forwarding a copy of the data file via a network to a central server (*Kadaba*: figures 1-10).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Kadaba* with the combined teachings of *Pipinsure* and *Keuper* with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (*Kadaba*: col. 3, lines 40-64).

(C) As per original claim 9, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, further comprising storing the data file on a server connected to a network, wherein the server provides access to the data file via the network.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper*. In particular, *Keuper* discloses the method as recited in claim 1, further comprising storing the data file on a server connected to a network, wherein the server provides access to the data file via the network (*Kadaba*: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Kadaba* with the combined teachings of *Pipinsure* and *Keuper*

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with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (*Kadaba*: col. 3, lines 40-64).

(D) Claim 19 substantially repeats the same limitations as claims 1, 6, and 9 and therefore, is rejected for the same reasons given for claims 1, 6, and 9 and incorporated herein.

5. Claims 5, 7, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Pipinsure* and *Keuper*, as applied to claim 1 above, and further in view of Official Notice.

(A) As per claim 5, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, further comprising forwarding copies of the data file via the network to one or more predetermined email addresses.

Nevertheless, Official Notice is taken that it is old and well known within the computer arts to transmit information via a network to an email address. The technique of using networks, such as, the Internet, intranets, wide area networks (WANs), local area networks (LANs), to transmit information across their lines to email addresses using, *inter alia*, Outlook Express, Hotmail, and Yahoo was notoriously well known and widely used at the time of the present invention and was developed to, *inter alia*, facilitate the transmission and sharing of information.

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the technique of transmitting information via a network to an email address with the combined teachings of *Pipinsure* and *Keuper* with the motivation of facilitating the transmission and sharing of information.

(B) As per original claim 7, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, further comprising shipping the item using the least expensive routing.

Nevertheless, Official Notice is taken that it is old and well known within the shipping and parcel delivery arts to ship items using the least expensive routing. This technique was well known and widely used at the time of the present invention by, for example, price conscientious consumers striving to minimize expenses and by corporate entities striving to maximize profits/revenue through cost containment.

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the technique shipping items using the least expensive routing with the combined teachings of *Pipinsure* and *Keuper* with the motivation of minimizing costs/expenses and/or maximizing profits/revenues.

(C) As per claim 10, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, wherein storing the data file comprises data in an XML format.

Nevertheless, Official Notice is taken that it is old and well known within the computer arts to store data in eXtensible Markup Language (XML) format. This

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technique was well known and widely used at the time of the present invention. For example, corporate organizations routinely formatted their documents in XML to create their own customized "tags," thereby enabling the definition, transmission, validation, and interpretation of data between applications and between organizations.

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the technique storing data in XML format with the combined teachings of *Pipinsure* and *Keuper* with the motivation facilitating the transmission of data between applications and/or organizations over a network.

(D) As per claim 11, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, wherein the network data is exchanged in an XML format.

Nevertheless, Official Notice is taken that it is old and well known within the computer arts to exchange network data in an XML format for substantially the same reasons given for claim 10 above and incorporated herein.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Pipinsure* and *Keuper*, as applied to claim 1 above, and further in view of *eBay* (<http://www.ebay.com>; hereinafter *eBay*).

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(A) As per original claim 16, *Pipinsure* fails to expressly disclose the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item before, during, or after shipping.

Nevertheless, this feature is old and well known in the art, as evidenced by eBay. In particular, eBay discloses the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item before, during, or after shipping (*eBay: Why eBay is Safe; How to Add a Photo to Your Item Listing*).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of eBay with the combined teachings of *Pipinsure* and *Keuper* with the motivation of providing a means for archiving the condition of an item for insurance claims purposes (*eBay: Why eBay is Safe*).

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Pipinsure* and *Keuper*, as applied to claim 1 above, in further view of *Chen et al.* (5,504,674; hereinafter *Chen*), and further in view of knowledge generally available to one having ordinary skill in the art.

(A) As per original claim 17, *Pipinsure* fails to expressly disclose the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt.

Nevertheless, this feature is old and well known in the art, as evidenced by *Chen* and knowledge generally available to one having ordinary skill in the art. In particular,

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*Chen* discloses the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt (*Chen*: abstract). Furthermore, taking photographs of items to document the physical condition of the items at different time frames (e.g., after shipment, etc.) for, *inter alia*, evidentiary and/or insurance claim purposes is notoriously well known. For example, customers of parcel carriers, such as, FedEx™ and UPS™, are advised to document (e.g., photograph) any damage to their parcels/goods upon receipt in order to ensure successful insurance claims. Another example involves car rental agencies. Before a customer rents a vehicle from a car rental agency the agency meticulously documents the condition of a vehicle. Upon return of the vehicle, the car rental agency will photograph any damage to their vehicle to maintain the proper documentation for insurance claims purposes.

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Chen* and knowledge generally available to one having ordinary skill in the art with the combined teachings of *Pipinsure* and *Keuper* with the motivation of providing a means for assessing damage for insurance claim processing purposes (*Chen*: abstract).

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Pipinsure* and *Keuper*, as applied to claim 1 above, and further in view of *Kepler* (5,347,845; hereinafter *Kepler*).

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(A) As per original claim 18, *Pipinsure* fails to *expressly* disclose the method as recited in claim 1, wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file.

Nevertheless, these features are old and well known in the art, as evidenced by *Keuper* and *Kepler*. In particular, *Keuper* and *Kepler* disclose the method as recited in claim 1, wherein the memory device (*Keuper*: abstract) comprises an air testing device configured to test air samples for contaminants (*Kepler*: abstract; col. 2, lines 25-35) and to store test results in the data file (*Keuper*: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Keuper* with the teachings of *Pipinsure* and *Kelper* with the motivation of acquiring shipment-handling data on an item (*Keuper*: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of *Kepler* with the combined teachings of *Pipinsure* and *Keuper* with the motivation of detecting the presence of contaminants in shipping containers (*Kepler*: col. 2, lines 33-35).

### ***Response to Arguments***

9. Applicant's arguments filed 10/19/06 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 10/19/06.

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(A) On pages 7-8 of the 10/19/06 response, Applicant argues that the cited art fails to teach or suggest a method for arranging insurance for an item, wherein the method comprises, in part, receiving a request to insure the item being shipped from an origination to a final destination. More specifically, Applicant argues that *Pipinsure's* teaching of a request for a savings quote is not a request to insure an item.

In response, Examiner disagrees with Applicant's *Pipinsure* interpretation, which appears to have been done in a vacuum. Examiner respectfully submits that the teachings of the applied prior art in combination with the knowledge available to one of ordinary skill in the art, *in toto*, do indeed teach and suggest Applicant's claimed features under a broad, yet reasonable, interpretation.

First, Examiner opines that a request for a savings quote is inherently a request to insure an item. That is, broadly and reasonably speaking, a request for a savings quote is a tacit request to insure an item, irrespective whether the request is consummated.

Second, *Pipinsure* is not in the business of merely providing savings quotes; rather, *Pipinsure* is in the business of insuring parcels (*i.e.*, items to be shipped). As such, a skilled artisan in the insurance and parcel shipping arts would easily glean from the complete *Pipinsure* teachings that a request to insure an item is taught and suggested by the *Pipinsure* reference. Moreover, skilled artisans would equally be cognizant that the *Pipinsure* reference teaches and suggests insuring parcels (*i.e.*, items) from an origination to a final destination—the fundamental premise of parcel/shipping insurance. For example, *Pipinsure* discloses various shipping cost



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scenarios from Dallas, TX (i.e., origination) to Pittsburgh, PA (i.e., final destination) (See *Pipinsure*: pp. 18.)

Third, Examiner respectfully submits that Applicant was not the first to invent the concept of insuring items to be shipped from an origination to a final destination. In fact, those of ordinary skill in the art are well aware of this business model and technique that was developed and used well prior to Applicant's claimed invention (e.g., United States Postal Service, Federal Express, UPS, etc.).

Lastly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(B) On page 8 of the 10/19/06 response, Applicant argues that the cited art fails to teach or suggest searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item. More specifically, Applicant argues that *Pipinsure*'s teaching of a table of potential savings is not the same as searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item.

In response, Examiner disagrees with Applicant's *Pipinsure* interpretation, which appears to have been done in a vacuum. Examiner respectfully submits that the teachings of the applied prior art in combination with the knowledge available to one of

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ordinary skill in the art, *in toto*, do indeed teach and suggest Applicant's claimed features under a broad, yet reasonable, interpretation.

First, Examiner respectfully submits that a broad, yet reasonable, interpretation of database reads on a table. As such, *Pipinsure* does indeed teach and suggest searching a database (e.g., table) for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item (See *Pipinsure*: pp. 18).

Second, Examiner respectfully submits that Applicant was not the first to invent the concept of searching insurance databases having specified levels of insurance coverage for items. In fact, those of ordinary skill in the art are well aware of this technique that was developed and used well prior to Applicant's claimed invention (e.g., United States Postal Service, Federal Express, UPS, *etc.*).

Lastly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(C) On pages 8-9 of the 10/19/06 response, Applicant argues that the cited art fails to teach or suggest generating a data file comprising at least item information and insurer information. More specifically, Applicant argues that a form on a web page that

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allows users to request a savings quote is not the same as generating a data file comprising at least item information and insurer information.

In response, Examiner disagrees with Applicant's *Pipinsure* interpretation, which appears to have been done in a vacuum. Examiner respectfully submits that the teachings of the applied prior art in combination with the knowledge available to one of ordinary skill in the art, *in toto*, do indeed teach and suggest Applicant's claimed features under a broad, yet reasonable, interpretation.

First, Examiner respectfully submits that a broad, yet reasonable, interpretation of data file reads on a web form. As such, *Pipinsure* does indeed teach and suggest generating a data file comprising at least item information and insurer information (See *Pipinsure*: pp. 8).

Second, Examiner respectfully submits that Applicant was not the first to invent the concept of generating a data file comprising item information and insurer information. In fact, those of ordinary skill in the art are well aware of this technique that was developed and used well prior to Applicant's claimed invention (e.g., United States Postal Service, Federal Express, UPS, etc.).

Lastly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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(D) On pages 9-10 of the 10/19/06 response, Applicant argues that the cited art fails to teach or suggest storing the data file, containing both item information and insurer information, in a memory device that accompanies the item. More specifically, Applicant argues that the data stored in *Keuper's* barrel tag transponder does not include insurer information.

In response, Examiner disagrees with Applicant's *Keuper* interpretation, which appears to have been done in a vacuum. Examiner respectfully submits that the teachings of the applied prior art in combination with the knowledge available to one of ordinary skill in the art, *in toto*, do indeed teach and suggest Applicant's claimed features under a broad, yet reasonable, interpretation.

First, Examiner respectfully submits that whereas *Pipinsure* teaches insurer information, *Keuper* teaches storing data files in memory devices that accompany an item. See *Pipinsure* and *Keuper*, generally.

Second, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As such, Applicant's claimed feature reads on *Keuper's* teaching of storing a data file in a memory device that accompanies.

Third, Examiner respectfully submits that Applicant was not the first to invent the concept of storing insurer information and data files in memory devices that accompany items. In fact, those of ordinary skill in the art are well aware of this technique that was

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developed and used well prior to Applicant's claimed invention (e.g., United States Postal Service, Federal Express, UPS, etc.).

Lastly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(E) On page 10 of the 10/19/06 response, Applicant argues that the Examiner has failed to provide a proper motivation to combine the teachings of *Pipinsure* with the teachings of *Keuper*.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Examiner respectfully submits that the motivations to combine the references used throughout this rejection are adequate. See sections 3-8, *supra*.

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(F) On page 11 of the 10/19/06 response, Applicant traverses the Examiner's taking of Official Notice of claim 5 and asserts that it is not well known in the prior art.

In response, Examiner notes that in order to adequately traverse such an Official Notice finding, the Applicant must specifically point out the supposed errors in the examiner's action, which would include *stating why the noticed fact is not considered to be common knowledge or well-known in the art* [Emphasis added]. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.").

Moreover, if Applicant does not traverse the Examiner's assertion of Official Notice or Applicant's traverse is not adequate, the Examiner should clearly indicate in the next Office Action that the common knowledge or well-known in the art statement is taken to be admitted prior art because Applicant either failed to traverse the Examiner's assertion of Official Notice or that the traverse was inadequate. If the traverse was inadequate, the Examiner should include an explanation as to why it was inadequate.

Accordingly, Examiner respectfully submits that Applicant's traverse of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art. As such, the features rejected via Official Notice are deemed to be admitted prior art.

(G) On page 12 of the 10/19/06 response, Applicant argues that the cited art fails to teach or suggest forwarding a copy of the data file via a network to a central server.

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Applicant also argues that the cited art does not teach or suggest a data file comprising insurer information.

In response, Examiner disagrees with Applicant's *Keuper* and *Kadaba* interpretation, which appears to have been done in a vacuum. Examiner respectfully submits that the teachings of the applied prior art in combination with the knowledge available to one of ordinary skill in the art, *in toto*, do indeed teach and suggest Applicant's claimed features under a broad, yet reasonable, interpretation.

First, Examiner respectfully submits that a broad, yet reasonable, interpretation of central server reads on a central tracking computer. As such, *Kadaba* does indeed teach and suggest teach a central server and *Keuper* does indeed teach and suggest forwarding a copy of the data file via a network (See *Kadaba*: Fig. 2 and *Keuper*, generally. Examiner notes that *Pipinsure* also teaches this features, albeit, not expressly.).

Second, Examiner respectfully submits that Applicant was not the first to invent the concept of forwarding a copy of a data file via a network to a central server. In fact; those of ordinary skill in the art are well aware of this technique that was developed and used well prior to Applicant's claimed invention.

Third, Examiner respectfully submits that although *Kadaba* does not teach insurer information *per se*, *Pipinsure* does.

Fourth, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is

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capable of performing the intended use, then it meets the claim. As such, Applicant's claimed feature reads on *Keuper's* and *Kadaba's* teaching of forwarding a copy of the data file via a network to a central server.

Lastly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(H) On page 13 of the 10/19/06 response, Applicant traverses the Examiner's taking of Official Notice of claim 7 and asserts that it is not well known in the prior art.

In response, Examiner notes that in order to adequately traverse such an Official Notice finding, the Applicant must specifically point out the supposed errors in the examiner's action, which would include *stating why the noticed fact is not considered to be common knowledge or well-known in the art* [Emphasis added]. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.").

Moreover, if Applicant does not traverse the Examiner's assertion of Official Notice or Applicant's traverse is not adequate, the Examiner should clearly indicate in the next Office Action that the common knowledge or well-known in the art statement is taken to be admitted prior art because Applicant either failed to traverse the Examiner's



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assertion of Official Notice or that the traverse was inadequate. If the traverse was inadequate, the Examiner should include an explanation as to why it was inadequate.

Accordingly, Examiner respectfully submits that Applicant's traverse of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art. As such, the features rejected via Official Notice are deemed to be admitted prior art.

(I) On pages 13-14 of the 10/19/06 response, Applicant traverses the Examiner's taking of Official Notice of claim 10 and asserts that it is not well known in the prior art.

In response, Examiner notes that in order to adequately traverse such an Official Notice finding, the Applicant must specifically point out the supposed errors in the examiner's action, which would include *stating why the noticed fact is not considered to be common knowledge or well-known in the art* [Emphasis added]. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.").

Moreover, if Applicant does not traverse the Examiner's assertion of Official Notice or Applicant's traverse is not adequate, the Examiner should clearly indicate in the next Office Action that the common knowledge or well-known in the art statement is taken to be admitted prior art because Applicant either failed to traverse the Examiner's assertion of Official Notice or that the traverse was inadequate. If the traverse was inadequate, the Examiner should include an explanation as to why it was inadequate.

Accordingly, Examiner respectfully submits that Applicant's traverse of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art. As such, the features rejected via Official Notice are deemed to be admitted prior art.

(J) On page 14 of the 10/19/06 response, Applicant traverses the Examiner's taking of Official Notice of claim 11 and asserts that it is not well known in the prior art.

In response, Examiner notes that in order to adequately traverse such an Official Notice finding, the Applicant must specifically point out the supposed errors in the examiner's action, which would include *stating why the noticed fact is not considered to be common knowledge or well-known in the art* [Emphasis added]. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.").

Moreover, if Applicant does not traverse the Examiner's assertion of Official Notice or Applicant's traverse is not adequate, the Examiner should clearly indicate in the next Office Action that the common knowledge or well-known in the art statement is taken to be admitted prior art because Applicant either failed to traverse the Examiner's assertion of Official Notice or that the traverse was inadequate. If the traverse was inadequate, the Examiner should include an explanation as to why it was inadequate.

Accordingly, Examiner respectfully submits that Applicant's traverse of Official Notice was inadequate because Applicant did not state why the noticed fact is not

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considered to be common knowledge or well-known in the art. As such, the features rejected via Official Notice are deemed to be admitted prior art.

(H) On page 15 of the 10/19/06 response, Applicant argues that the Examiner has improperly ignored the specific differences between the claim limitations of claims 1 and 19.

In response, Examiner disagrees with Applicant's interpretation of the prior art, which appears to have been done in a vacuum. Examiner respectfully submits that the teachings of the applied prior art in combination with the knowledge available to one of ordinary skill in the art, *in toto*, do indeed teach and suggest Applicant's claimed features under a broad, yet reasonable, interpretation.

First, Examiner rejected the aforementioned claim based on substantially the same reasons as those given for the other claims, that is, the method claims, on the basis that they *substantially* repeated the same limitations as the former [Emphasis added].

Second, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As such, Applicant's claimed feature reads on the combined teachings of the prior art.

Lastly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the

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rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(I) Applicant's remaining arguments in the response filed 10/19/06 rely on or re-hash the issues addressed above and in the previous Office Action and therefore, are moot in view of the responses given and incorporated herein.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

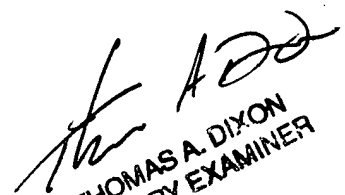
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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT



THOMAS A. DIXON  
PRIMARY EXAMINER